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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/597,263	07/18/2006	Nobutaka Nakajima	39951	8493
116 7590 03/17/2009 PEARNE & GORDON LLP 1801 EAST 9TH STREET SUITE 1200 CLEVELAND, OH 44114-3108			EXAMINER ELVE, MARIA ALEXANDRA	
			ART UNIT 3742	PAPER NUMBER
			MAIL DATE 03/17/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/597,263

Applicant(s)

NAKAJIMA ET AL.

Examiner

M. Alexandra Elve

Art Unit

3742

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 July 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SI/309)
- Paper No(s)/Mail Date 12/28/07, 7/18/06
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kiser (USPN 6,242,113) in view of Kudo et al. (USPN 4,400,209) and Kawaguchi et al. (JP 11-170084).

Kiser discloses a welding alloy, weldments (i.e. filler) and so forth. the alloy is nickel, chromium and iron based and contains the following: C (0.005-0.05), Si (<0.50), Mn (<1.0), Cr (27-31.5), Nb (0.60-0.95), Ta (<0.10), Fe (7-11), Al (0.01-0.25), Ti (0.01-0.35), P (<0.02), S (<0.01), B (<0.01), Zr (<0.10) and balance Ni.

Kiser does not teach the presence of vanadium, nitrogen, calcium, magnesium, rare earths or oxygen; however, these elements do not specifically have to be present.

Kudo et al. discloses a high nickel, chromium and iron alloy. the composition follows: C (< 0.1), Si (<1.0), Mn (<2.0), Cr (22.5-40), Nb, Ta, Ti, Zr and V in amounts of one or more to a total amount of (0.5-4.0), P(<0.003), S (<0.005), N (0-0.30), Ca (0-0.10), Mg (0-0.10), rare earths (0-0.10), Fe (balance) and Ni (25-60).

It would have been obvious to one of ordinary skill in the art at the time of the invention to use vanadium, calcium, magnesium and rare earths as taught by Kudo et al. in the Kiser welding alloy because rare earths, Ca and Mg are known for improving

ductility (hot workability), vanadium forms nickel intermetallics for hardening and nitrogen in controlled amounts add strengthening to the alloy matrix.

Kawaguchi et al. discloses a filler metal for Ni based, high Cr alloys. the filler metal contains: C (<0.04), Si (0.1-0.5), Mn (0.2-1), Cr (28-31.5), Nb (<0.1), Fe (7-11), Al (0.5-1.1), Ti (0.5-1), P (<0.02), S (<0.01), Nb (<0.1), V (0.05-0.5), N (<0.03), O (<0.1) and balance Ni.

It would have been obvious to one of ordinary skill in the art at the time of the invention to minimize the amount of oxygen in the nickel based alloy as taught by Kawaguchi et al. because it is well known that nickel preferentially forms oxides whose presence weakens the alloy matrix.

The exact amounts of each of the constituents as presently claimed are not disclosed in the prior art; however, the prior art compositions closely approximates or overlap applicant's claimed composition. It has been held that one of ordinary skill in the art at the time of the invention would have considered the claimed compositions to have been obvious because close approximation or overlapping ranges in a composition is considered to establish a prima facie case of obviousness. See *In re Malagari*, 182 USPQ 549, *Titanium Metals v. Banner* 227 USPQ 773, *In re Nehrenberg* 126 USPQ 383.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Alexandra Elve whose telephone number is 571-272-1173. The examiner can normally be reached on 7:30-4:00 Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tu B. Hoang can be reached on 571-272-4780. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

March 13, 2009.

/M. Alexandra Elve/
Primary Examiner, Art Unit 3742